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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/898,875	07/02/2001	Tsuyoshi Miyano	ALPSP020	2209
22434	7590	07/27/2006		EXAMINER
BEYER WEAVER & THOMAS, LLP P.O. BOX 70250 OAKLAND, CA 94612-0250			GRANT II, JEROME	
			ART UNIT	PAPER NUMBER
			2625	

DATE MAILED: 07/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/898,875	MIYANO, TSUYOSHI
	<b>Examiner</b>	<b>Art Unit</b>
	Jerome Grant II	2626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 05 June 2006.
- 2a) This action is FINAL.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1 and 3-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) 1,3-8 and 17 is/are allowed.
- 6) Claim(s) 9,10 and 14-16 is/are rejected.
- 7) Claim(s) 11-13 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

JEROME  
PRIMARY  
EXAMINER

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.

- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_.

### **Detailed Action**

1.

#### **Rejected Claims**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 9 and 10 are rejected under 35 U.S.C. 102(e) as being anticipated by Manchala.

With respect to claim 9, Manchala teaches a printer (11) comprising: print head, as the means for printing images, see figure 3; Manchala teaches a shredder 14 as the means for cutting; software application as the means for sensing authentication (such as a pin and password of operation) as the means for characterizing a document (bank check); and means for sending the authentication data (col. 4, line 65- col. 5, line 3) to a server (10); causing the cutter to cut the document to invalidation, col. 2, lines 40-49; sending data ( NVRAM entry data) representing completion of the invalidation of the document to the server ( col. 2, lines 38-50).

With respect to claim 10, Manchala teaches a method for invalidating a document (check), comprising: sensing authentication characteristics (pin and password of operation), see col. 3, lines 10-15 regarding a check, see col. 2, lines 17-30; sensing authentication characteristics of the document; outputting a sensor signal (MICR data or the magnetic operation) corresponding to the sensed characteristics; sending authentication data (col. 4, line 65-col. 5, line 3 representing the sensor signal to a (application server 10); causing a cutter 14 to invalidate the check (document); and

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sensing data NVRAM entry data of the invalidation of the document to the server (client 10), see col. 2, lines 31-50.

2.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Machala in view of the Well Known Prior Art (Official Notice).

With respect to claims 14 and 15, Machala teaches a printer and a means to cut documents, however, the location of how the document is placed in the cutter is not known with respect to the printer.

However, applicant has not submitted a reason that a cutter incorporated in a printer would solve a problem anticipated in the art.

Since, the shredder 14 is provided with the printer 11, one of skill would have known to make the shredder integral with the printer for the convenience of shredding documents which are regarded as invalidated within the printer housing.

With respect to claim 16, Machala teaches a cutter and receiving signals to initiate the cutting of the document. Machala teaches sensing information on a magnetic strip. The magnetic strip contains a code for determining if a check should be cut (shredded), see col. 2, lines 44- 63. Hence, Machala uses a magnetic sensor to sensing the verification data regarding the shredding of the document.

3.

**Claims Objected to As Containing Allowable Subject Matter**

Claims 11-13 are objected to as containing allowable matter.

4.

**Allowed Claims**

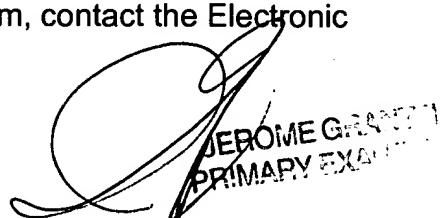
Claims 1, 3-8 and 17 are allowed based upon the new amendment received June 5, 2006.

5.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jerome Grant II whose telephone number is 571-272-7463. The examiner can normally be reached on Mon.-Thurs. from 9:00 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Moore, can be reached on 571-272-4737. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



JEROME GRANT II  
PRIMARY EXAMINER